

REMARKS

I. General Remarks

Claims 8, 11, and 13 are currently amended. Claims 27-29 have been added as new claims. Applicants have considered all points made by the Examiner in the Office Action and has responded to same in order to ensure compliance with the applicable rules.

II. Remarks Regarding the Amendments to the Specification

Paragraph [23] has been amended to correct a typographical error. As this amendment merely corrects a typographical error, Applicants respectfully submit that no new matter has been added by this amendment.

III. Remarks Regarding the 35 U.S.C. 102(b) Rejections

Claims 8 and 11 stand rejected under 35 U.S.C. §102(b) as being anticipated by Behrenfeld (U.S. 5,986,196). Applicants respectfully traverse the rejection and submit that amended claims 8 and 11 are allowable over Behrenfeld.

Anticipation is a factual determination. In order to establish anticipation, it is incumbent upon the Examiner to identify in a single prior art reference disclosure of each and every element of the claims in issue, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 U.S.P.Q. 481 (Fed. Cir. 1984); *In re Schaumann*, 572 F.2d 312, 197 U.S.P.Q. 5 (C.C.P.A. 1978) (anticipation is measured with respect to the terms of the claims in issue). When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, or the inclusion of options not disclosed in the reference, the reference does not anticipate. *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1480, 1 U.S.P.Q.2d 1241, 1245-46 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909, 107 S.Ct. 2490 (1987).

Behrenfeld teaches and claims an “impact pad,” and teaches that (1) “*All* impact pads protect the drum head from the striking implement[,]” (col. 3, lines 30 – 31, emphasis added) and (2) “*All* impact pads are primarily protective devices” (col. 3, line 35, emphasis added). So, an impact pad is necessarily located at the point of impact, because it must protect the drum head from the striking implement. As the examiner indicated, Behrenfeld teaches that “[i]mbedding a disc in the hand or arm *of the impact pad* can be employed to absorb vibration which in turn dampens the drum sound

....” (col. 3, lines 61 – 64, emphasis added). Behrenfeld also teaches that “[t]he *impact pad* may have at least one of the arms extending beyond the radius of curvature” (col. 6, lines 9 – 10, emphasis added). These both describe possible features of an impact pad, which Behrenfeld teaches must protect the drum head from the striking implement. Behrenfeld does not teach any way of protecting the drum head from the striking implement except for positioning the impact pad at the point of impact.

In contrast, Applicants’ amended claims 8 and 11 are restricted to an oil-free patch “wherein no portion of the patch is positioned on a vibratable surface at other than a point of impact.” These claims expressly exclude what Behrenfeld teaches is a necessary characteristic of an impact pad. Thus, even though both inventions result in controlling sound, Behrenfeld’s impact pad does not anticipate the Applicants’ claims, the functionality of Behrenfeld is destroyed by placement away from the impact area.

Further, Behrenfeld focuses on minimizing drum distortion from an impact and “disburs[ing] the mass of the impact pad over a greater effective area without causing significant drum head distortion.” *See* Behrenfeld, Abstract and col. 2, lines 19-21. Thus, it is important that the impact pad be of Behrenfeld be located at the point of impact. The patch of the present invention, on the other hand, is directed to minimizing “unwanted and undesirable overtones, sometimes referred to as ring or over-ring.” *See* Present Application [02] at 2. Thus, it is desirable that the patch be located at a non-impact portion of the drum. The amendments herein clarify this difference between the patch of the present invention and the impact pad of the Behrenfeld prior art.

In light of the above, Applicants respectfully submit that amended claims 8 and 11 are not anticipated by Behrenfeld. Accordingly, Applicants respectfully request the Examiner to withdraw the 35 U.S.C. § 102(b) rejection as to amended claims 8 and 11.

IV. Remarks Regarding the 35 U.S.C. 103(a) Rejections

Claims 13 – 17 stand rejected under 35 U.S.C. 103(a) as unpatentably obvious over Fyfe in view of Iiyama and further in view of Behrenfeld. Applicants respectfully submit that the claims are patentable over the prior art, because they include elements not disclosed in the prior art, there is no motivation to combine the references, and Behrenfeld teaches away from the claimed invention.

A. The Amended Claims Include Elements Not Disclosed in the Prior Art

“To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all the claim limitations,” M.P.E.P. § 2143; *see also, In re*

Vaack, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Amended claim 13 (and claims 14–17 by incorporation) includes the following elements not disclosed in the prior art.

1. First Element Not Disclosed: “laying a sheet of base material other than a woven fabric onto the polyurethane mix”

Fyfe does not teach laying a sheet of base material other than a woven fabric. Fyfe teaches and claims a textile, which Merriam-Webster’s defines as (1) cloth; especially : a woven or knit cloth and (2) a fiber, filament, or yarn used in making cloth. As an example of the textile, Fyfe teaches a cloth woven of fiberglass, graphite fiber, or Kevlar, with openings between 0.06 and 1.0 inch across (col. 2, lines 44 – 47). None of Fyfe’s teachings specify or imply a base material that is not a woven fabric. Further, none of the other cited prior art references supply this missing element.

2. Second Element Not Disclosed: “applying the cured polyurethane mix and base material to a vibratable surface of the musical instrument wherein no portion of the cured polyurethane mix and base material is applied at a point of impact”

None of the cited prior art references teach the step of “applying the cured polyurethane mix and base material to a vibratable surface of the musical instrument wherein no portion of the cured polyurethane mix and base material is applied at a point of impact.”

B. There is No Motivation or Suggestion Found in the Prior Art to Combine Fyfe, Iiyama, and Behrenfeld to Arrive at the Specific Combination of Elements Recited in Applicants’ Claims

In addition to the cited prior art failing to teach all of the elements recited in Applicants’ claims, there is no motivation to combine Fyfe, Iiyama, and Behrenfeld. In order to render the claimed invention obvious, the prior art must suggest a motive to modify the reference or to combine reference teachings. *See In re Vaack*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1981). The mere fact that references can be combined or modified does not render the resultant combination obvious. The prior art must suggest the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

The Examiner proposes that one skilled in the relevant art would have been motivated to combine these three references. But the patents’ classifications suggest otherwise. Fyfe and Behrenfeld, both U.S. patents, share no common classifications. Behrenfeld is classified under 84/411 (Music/drums), and specifically mutes and pads. Fyfe is classified under several sub-classes of 442 (Fabric (Woven, Knitted, or Nonwoven Textile or Cloth, etc.)) and two sub-classes of 52 (Static Structures (e.g., buildings)). And, Iiyama is classified under international classifications B29

(plastics) and B05 (spraying or atomizing). In fact, none of the three references share so much as a top-level U.S. or international classification. These classifications are evidence of nonanalogy between prior art references. M.P.E.P. § 2141.01(a).

The Examiner may contend that there may be a slight motivation to combine Fyfe and Iiyama, because one of Iiyama's ten international classifications is B29K 75 (moulding material for reinforcement/polyurethane), which is analogous to Fyfe's stated purpose of reinforcing large structures against blasts and other irregular forces. But, if that is where Fyfe intersects with Iiyama, it is a tremendous logical leap from that art to protecting a drum head from the stretching caused by the regular impact of a striking implement. Thus, Fyfe and Iiyama are not "reasonably pertinent to the particular problem with which [Behrenfeld] is involved," as required for obviousness. *See In re Clay*, 25 U.S.P.Q.2d 1059, 1060 (Fed. Cir. 1992).

Further, Fyfe is concerned with using composite coatings to improve the resistance to blast or seismic forces of a structure. *See e.g.*, Fyfe, Abstract. The problem in the art that Fyfe seeks to solve has no relation whatsoever to dampening of vibrating surfaces of musical instruments so as to modify the sound of the musical instrument. Nor does Iiyama have any relevance to dampening vibrating surfaces of musical instruments either. Indeed, Iiyama contains no teaching of the use of patches on vibrating surfaces.

The Examiner appears to attempt to supply the motivation to combine references with the naked statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate [the teachings of the prior art]." To the extent that the Examiner is relying on common or personal knowledge or taking official notice without documentary evidence to supply the missing elements or motivation to combine or modify the cited references, including unsubstantiated statements of what would be obvious to a person having ordinary skill in the art such as the statement in the Office Action at 4 and 5, Applicants respectfully traverse under M.P.E.P. § 2144.03(C) by requesting either (1) documentary evidence establishing the missing motivation to combine/modify the cited references, or (2) an affidavit setting forth the specific factual statements and explanation to support the Examiner's finding in accordance with 37 C.F.R. § 1.104(d)(2).

C. Behrenfeld Teaches Away from Applicants' Claims

Notwithstanding the foregoing, Applicants' invention is not obvious because Behrenfeld teaches away from the invention. As previously shown, Behrenfeld teaches an "impact pad" and that "[a]ll impact pads protect the drum head from the striking implement." (col. 3, lines 29–30). In

contrast, the present invention is not “primarily [a] protective device[.]” In fact, it is disposed so as to not interfere with the striking implement at all, contrary to Behrenfeld’s teaching.

Further, Behrenfeld focuses on minimizing drum distortion from an impact and “disburs[ing] the mass of the impact pad over a greater effective area without causing significant drum head distortion.” *See* Behrenfeld, Abstract and col. 2, lines 19-21. Thus, it is important that the impact pad of Behrenfeld be located at the point of impact. The patch of the present invention, on the other hand, is directed to minimizing “unwanted and undesirable overtones, sometimes referred to as ring or over-ring.” *See* Present Application [02] at 2. Thus, it is desirable that the patch be located at a non-impact portion of the drum. The amendments herein clarify this difference between the patch of the present invention and the impact pad of the Behrenfeld prior art.

In light of the above, Applicants respectfully submit that claims 13–17 are not obvious because the prior art does not disclose all of the elements of those claims, there is no motivation to combine the references, and Behrenfeld teaches away from the claimed invention.

CONCLUSION

A check has been enclosed for \$260 (for the excess claim fee of \$200 for two additional independent claims and for a one month extension fee of \$60, which extends the time for reply up to and including September 19, 2006). Authorization is hereby given to charge Deposit Account No. 10-0096 for any deficiency of fees.

The Applicants request a telephone call if there are any problems associated with this Response, as this Response is believed to put the case in condition for allowance.

At this time and in view of Applicants' amendments and arguments set forth above, Applicants respectfully submit that all pending claims are allowable and respectfully requests a notice of allowance.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited on the date shown below with the United States Postal Service as First Class Mail in an envelope addressed to Mail Stop: Response/Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, as follows:

Dated: _____

Shirley McIntyre